

CASE NO.: STL9-2000-0035-US1
Serial No.: 09/922,182
July 13, 2007
Page 2

PATENT
Filed: August 2, 2001

"accessing saved advertisements by the user on the display of the user computer", but that is not what is claimed. The rejection is overcome.

Moreover, the relied-upon portion of LeMole et al. does not address advertisements that are saved *at the user computer* as claimed, but rather an "advertising page" on a server that subsequently can be accessed by the user computer, see col. 6, lines 20-45. The page dynamically changes at the server, col. 6, line 38, but in any case (1) nothing in the relied-upon section of LeMole et al. indicates that it is saved on the user computer, much less that it is displayed in its own advertising history window on the user computer.

2. The rejection of Claim 1 fails to mention the limitation of allowing *a user* to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display. The closest the rejection comes to alleging that the recited limitation is in the reference is in paragraph "d" on page 4 of the Office Action, alleging that col. 5, lines 16-22 of LeMole et al. teaches "filtering previously displayed advertisements to determine eligible advertisements", and the reason the Office Action studiously avoids alleging that the filtering is done by the user as claimed is because in LeMole et al., it isn't. The relied-upon portion of the reference makes clear that the "filtering" is done by the CAR server 111. The rejection is overcome.

3. The rejection of Claim 4 alleges that figure 2 of LeMole et al. allows a user to scroll through the saved advertisements, pointing to the scroll bar shown in the figure. This is incorrect. Figure 2 shows a registration form used to select genres of advertisements, not saved advertisements themselves. The rejection of Claim 4 is further overcome.

4. The rejection of Claim 6 alleges that LeMole et al., figure 2 and col. 6, line 63-col. 7, line 35 teaches displaying and using back and forward buttons to navigate through the saved advertisements, but

1176-3.AM5

CASE NO.: STL9-2000-0035-US1

Serial No.: 09/922,182

July 13, 2007

Page 3

PATENT

Filed: August 2, 2001

this is incorrect. As clarified above, figure 2 has nothing to do with saved advertisements, but only permits a user to register for certain genre of ads. The cited portions of the LeMole et al. specification discuss clicking on ads in the ad page at the server, not at the user computer. To the extent that the user is navigating through anything it through a live web page, not saved advertisements on the user computer.

5. The Office Action does not bother to separately address independent Claim 7, which fatally dooms the blanket rejection because Claim 7 requires limitations not found in Claim 1. For example, Claim 7 requires that the server transmit the Internet advertisements to the user computer while the user is engaged in activity other than requesting the advertisements, but this limitation has not been discussed in the Office Action. The rejection of Claim 7 has been overcome.

6. The comments apply *mutatis mutandis* to the rejection of independent Claim 13.

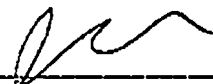
7. The examiner notes that he refuses to construe Claims 7-11 and 13-19 in accordance with the sixth paragraph of Section 112 because allegedly these claims fail to "pass" prongs 2 and 3 of the three-prong test. These "prongs" are, respectively, that the claim not recite a structural limitation, and that structure is taught in the specification to support the claimed means-plus-function elements. The rejection descends into illogic, however, by alleging that the claims, in reciting "logic means", "thus eliminat[e] any kind of physical structure", Office Action, page 3, line 10 - an explicit avowal on the record that the second prong in fact is met. The allegation that the third prong is not met because the specification teaches that "the means for performing these functions [are] part of a computer program" likewise is illogical. Every computer performs functions encoded in software. Under the examiner's reasoning no computer claim could ever be expressed under the sixth paragraph of Section 112. In fact, almost the entire page 5 of the specification expressly teaches structure that is correlated to the claimed functions.

1176.3.AM5

CASE NO.: STL9-2000-0035-US1
Serial No.: 09/922,182
July 13, 2007
Page 4

PATENT
Filed: August 2, 2001

Respectfully submitted,



John L. Rogitz
Registration No. 33,549
Attorney of Record
750 B Street, Suite 3120
San Diego, CA 92101
Telephone: (619) 338-8075

JLR:jg

11763AMS